

GENENTECH, INC.,  
 )  
 )  
 Plaintiff, )  
 v. )  
 )  
 THE TRUSTEES OF THE UNIVERSITY OF )  
 PENNSYLVANIA, )  
 )  
 Defendant. )

Case No.: C 10-02037 LHK (PSG)  
**ORDER GRANTING DEFENDANT'S  
 MOTION TO COMPEL AND  
 DENYING PLAINTIFF'S MOTION  
 FOR A PROTECTIVE ORDER**  
**(Re: Docket Nos. 258 and 256)**

Pursuant to Fed. R. Civ. P. 26(b), “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense. . . . Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.” The court, however, may “for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense.”<sup>1</sup>

1

1 Unless the court orders otherwise for the parties' and witnesses' convenience and in the interests of  
2 justice, methods of discovery may be used in any sequence, and discovery by one party does not  
3 require any other party to delay its discovery.<sup>2</sup>

4 Genentech requests a protective order to delay the depositions in the interests of justice to  
5 sanction Penn for its delayed production of supplemented infringement contentions. Genentech  
6 also argues that delaying the depositions until Penn supplements its infringement contentions  
7 would avoid burdensome depositions on irrelevant subjects and allow Genentech time to formulate  
8 its defenses before expert reports are due. Genentech finally argues that it should not be denied the  
9 opportunity to prepare its witnesses with Penn's further contentions in hand.

10 Penn responds that Genentech provided no reason why the infringement contentions are  
11 necessary for fact depositions. Penn also states that it has agreed to give reasonable supplemental  
12 information by the end of the month.

13 "The Court does not look favorably upon a 'tit-for-tat' approach to discovery. A party may  
14 not withhold relevant discovery simply on the basis that the other side has not been forthcoming  
15 with discovery."<sup>3</sup> "A party may not excuse its failure to comply with discovery obligations by  
16 claiming that its opposing party is similarly delinquent. Nor may a party condition its compliance  
17 with its discovery obligations on receiving discovery from its opponent."<sup>4</sup> Accordingly, Genentech  
18 may not condition its compliance with the deposition subpoenas on Penn's first producing a  
19 supplement to its infringement contentions.

20 Additionally, infringement contentions are not a precondition to fact discovery. To the  
21 contrary, the local patent rules and Rule 26 collectively allow for a period of 35 days where  
22 discovery is permitted without any infringement contentions having been served.<sup>5</sup> Here, Penn has

23 <sup>2</sup> See Fed. R. Civ. P. 26(d).

24 <sup>3</sup> *Richardson v. City of Antioch*, No. C-08-3470 JSW (EMC), 2009 WL 982118, at \*1 (N.D. Cal.  
25 Apr. 13, 2009).

26 <sup>4</sup> *Fresenius Med. Care Holding Inc. v. Baxter Int'l., Inc.*, 224 F.R.D. 644, 653 (N.D. Cal. 2004).

27 <sup>5</sup> Patent Local Rule 3-1 requires that "[n]ot later than 14 days after the Initial Case Management  
28 Conference, a party claiming patent infringement shall serve on all parties a 'Disclosure of  
Asserted Claims and Infringement Contentions.'" According to Fed. R. Civ. P. 26(d) and (f),  
discovery may commence after the parties meet for a Rule 26(f) conference, which must take place  
at least 21 days before the Initial Case Management Conference.

1 in fact served infringement contentions, and the court finds no reason why discovery cannot  
2 proceed in the absence of Penn's supplement to those contentions. It is certainly no reason that one  
3 or more Genentech fact witnesses would be better prepared to defend Genentech's positions with  
4 the further contentions in hand. Fact witnesses are to testify as to facts, whatever the effect on a  
5 party's position.

6 Because the court finds that Genentech has not shown good cause for a protective order, IT  
7 IS HEREBY ORDERED that Genentech's motion for a protective order is DENIED, and Penn's  
8 motion to compel is GRANTED.

9 Dated: June 10, 2011

10 

11 PAUL S. GREWAL  
12 United States Magistrate Judge  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28